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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,416

04/17/2006

Sherman Fong

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EXAMINER

WOODWARD, CHERIE MICHELLE

ART UNIT

PAPER NUMBER

1647

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,416	<b>Applicant(s)</b> FONG ET AL.	
	<b>Examiner</b> CHERIE M. WOODWARD	<b>Art Unit</b> 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-1477. Claims 1-5, drawn to nucleic acids, vectors, and host cells, with respect to SEQ ID NOs: 1-1477.

Group 1478 . Claim 6, drawn to a process for producing a PRO polypeptide comprising a host cell comprising SEQ ID NOs: 1-1477.

Groups 1479-2956. Claim 7, drawn to an isolated PRO polypeptide, with respect to SEQ ID NOs: 1-1477.

Groups 2957-4434. Claims 8-9, drawn to a fusion protein comprising a polypeptide of SEQ ID NOs: 1-1477 fused to a heterologous amino acid sequence.

Groups 4435-5912. Claims 10-11, drawn to an antibody that binds to any one of SEQ ID NOs: 1-1477.

Groups 5913-7390. Claims 12-14, drawn to a composition comprising a polypeptide of any one of SEQ ID NOs; 1-1477.

Groups 7391-8868. Claim 15, drawn to an article of manufacture comprising any one of SEQ ID NOs: 1-1477.

Groups 8869 -10346. Claims 16-17, drawn to a method of treating an immune related disorder comprising administering a polypeptide of SEQ ID NOs: 1-1477.

Groups 10347-11824. Claim 18, drawn to a method for determining the presence of a PRO polypeptide of SEQ ID NOs: 1-1477 in a sample.

Groups 11825-13302. Claims 19, 20, and 26, drawn to a method of diagnosing an immune related disease comprising detecting the level of expression of any of SEQ ID NOs: 1-1477.

Groups 13303-14780. Claim 21, drawn to a method of identifying a compound that inhibits the activity of a PRO polypeptide of SEQ ID NOs: 1-1477.

Groups 14781-16258. Claims 22-23, drawn to a method of identifying a compound that inhibits the expression of a gene encoding a PRO polypeptide of SEQ ID NOs: 1-1477.

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Groups 16259-17736. Claim 24, drawn to a method of identifying a compound that mimics the activity of a PRO polypeptide of SEQ ID NO: 1-1477.

Groups 17737-19214. Claim 25, drawn to a method of stimulating the immune response in a mammal comprising administering any one of SEQ ID NOs: 1-1477.

The inventions listed as Groups 1-19214 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1, drawn to SEQ ID NO: 1, lacks novelty as being anticipated by NCBI Accession NO: NM\_002794, Homo sapiens proteasome subunit, beta type, 2, mRNA (see also version gi: 19923146), 1992, which is 100% identical to instant SEQ ID NO: 1. Because claim 1, drawn to SEQ ID NO: 1, is anticipated, the inventions listed as Groups 1-19214 do not relate to a single general inventive concept under PCT Rule 13.1. Under PCT Rule 13.2, the claims lack the same or corresponding special technical features for the following reasons: the claims are drawn to 1477 distinct sequences, each of which are structurally and functionally distinct products (see also MPEP 1850). Pursuant to 37 CFR 1.475, a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ( "requirement of unity of invention "). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species are as follows:

SEQ ID NOs: 1-1477, which are structurally and functionally distinct sequences.

Additionally, the species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: SEQ ID NOs: 1-1477 are drawn to distinct nucleic acids and amino acids that are each structurally and/or functionally different, one from the other.

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3. Applicant is advised that the reply to this requirement to be complete **must include (i) an election of a species or invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERIE M. WOODWARD whose telephone number is (571)272-3329. The examiner can normally be reached on Monday - Friday 9:00am-5:30pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cherie M. Woodward/

Examiner, Art Unit 1647